The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED
JUL 29 2004
U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM P. STEARNS
and
NOZAR HASSANZADEH

Appeal No. 2004-0002
Application No. 09/678,318

ON BRIEF

Before KIMLIN, JEFFREY T. SMITH and PAWLIKOWSKI, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

REMAND TO THE EXAMINER

This application is remanded to the examiner for the purpose of providing a Supplemental Answer.

The present appeal involves the final rejection of claims 1-8 and 20-27. Claims 19 and 28 have been objected to by the examiner. Claims 1, 2, 20 and 21 stand rejected under 35 U.S.C.

§ 102(a) as being anticipated by Ohsawa. Claims 3, 4, 22 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohsawa. Claims 5-8 and 24-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohsawa in view of Karnezos.

Appellants' claimed invention is directed to a method of laying out traces for connection of bond pads of a semiconductor chip to a ball grid array disposed on a substrate. A central issue on appeal is whether Ohsawa describes, within the meaning of § 102, the claim 1 requirement that "each trace of each of said pair of traces being spaced from the other trace of said pair by up to a ball pitch, being maximized for identity in length and having up to one ball pitch difference in length and being maximized for parallelism and spacing."

The examiner states that Figure 3j of Ohsawa discloses the claim recitation (see page 4 of Answer, penultimate paragraph). The examiner does not point to any disclosure in the Ohsawa specification in support of his interpretation of Figure 3j. Appellants, on the other hand, contend that "a reading of the specification of Ohsawa and of that figure nowhere teaches or even remotely suggests the claimed step, regardless of the examiner's allegations to the contrary" (page 4 of principal brief, second paragraph). In response to appellants' contention,

the examiner maintains that Ohsawa clearly depicts the claim limitations and that "[appellant has [sic, appellants have] not pointed out specifically how Ohsawa does not read on claimed subject matter" (page 6 of Answer, third paragraph). Appellants submit the following in their Reply Brief:

> Clearly, nowhere in Ohsawa are there pairs of traces with the traces of each pair of traces spaced from each other by up to a ball pitch. In addition, nowhere in Ohsawa are the traces of a pair maximized for length identity with a length difference of up to one ball pitch. It follows that claim 1 defines patentably over Ohsawa under 35 U.S.C. 102(a) [page 2 of Reply Brief, first paragraph].
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> . . . The Examiner's Answer nowhere references any portion of the specification of Ohsawa which teaches that which is alleged to be contained in Ohsawa and the undersigned has been unable to locate any such discussion in Ohsawa. The source of the allegation of the showing in Ohsawa is therefore not apparent [page 2 of Reply Brief, third paragraph].

The initial burden, of course, is on the examiner to establish a prima facie case of anticipation under § 102 and obviousness under § 103. In the present case, the examiner's factual finding with respect to Figure 3j of Ohsawa has been challenged by appellants and, therefore, it is incumbent upon the examiner to establish on this record the validity of his

interpretation of Ohsawa's Figure 3j. The examiner's conclusion, without elaboration, is not sufficient.

Accordingly, the examiner is hereby authorized to submit a Supplemental Answer to explain why Figure 3j of Ohsawa meets the relevant recitation of claim 1 discussed above. Manifestly, appellants should be afforded an opportunity to respond to any Supplemental Answer provided by the examiner. Also, both the examiner and appellants may avail themselves of this opportunity to provide further discussion with respect to the § 103 rejections. The examiner should exercise caution, however, in not introducing a new ground of rejection unless, of course, prosecution is reopened.

The application is remanded to the examiner for the reasons set forth above pursuant to 37 CFR § 1.193(b)(1)(2003).

This application, by virtue of its "special" status, requires immediate action by the examiner. See the Manual of Patent Examining Procedure, § 708.01(D) (8th ed., Rev. 1, Feb. 2003). It is important that the Board of Patent Appeals and

Interferences be promptly informed of any action affecting the appeal in this case.

REMANDED

EDWARD C. KIMLIN)
Administrative Patent Judge)
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JEFFREY T. SMITH) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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BEVERLY PAWLIKOWSKI)
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